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YAHOO! INC. C/O GREENBERG TRAURIG, LLP

MET LIFE BUILDING

200 PARK AVENUE

NEW YORK, NY 10166

EXAMINER

UBER, NATHAN C

ART UNIT

PAPER NUMBER

4143

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/620,494

Applicant(s)

LUU, DUC THONG

Examiner

NATHAN C. UBER

Art Unit

4143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☒ Claim(s) 9, 13 and 39 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Status of Claims

1. This action is in reply to the application filed on 16 July 2003.
2. Claims 1-39 are currently pending and have been examined.

Drawings

3. The drawings are objected to because Figures 6a-6i are too dark and cannot be read. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
5. The use of the trademarks *DoubleClick Inc*, *America Online Inc*, and *Yahoo! Inc* has been noted in this application. They should be capitalized wherever they appear and be accompanied by the

generic terminology. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Objections

6. Claim 39 is objected to because of the following informalities: words appear to be missing from the claims such that the claim does not form a meaningful sentence (e.g. *...such that a ratio of the charges the total booked amount...* and *...effectiveness measure the goal effectiveness...*). Appropriate correction is required.
7. Claims 9 and 13 objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 9 repeats a limitation of Claim 8 verbatim and Claim 13 repeats Claim 11 verbatim.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
9. Claims 1, 4, 7, 16, 19, 22, 23, 24, 30, 32, 33, 36, 37, 39 and their dependants all recite limitations which lack sufficient antecedent basis in the claims. The Claims are replete with limitations lacking antecedent basis (for example Claim 19 which depends from Claims 1, 8, 11 and 13 recites *the subsequent week* and *the same calendar month* of which neither limitation appears in the preceding Claims) and many of the limitations are repeated in subsequent dependent claims. A list of terms lacking antecedent basis throughout the application is provided below:
 - Advertising campaign
 - Campaign

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- Apportioned GRP
- Apportioned booked amount
- Actual GRP
- Ration of recognized revenue
- Ration of actual GRP
- Total actual GRP
- Billing period
- Subsequent week
- Same calendar month
- Other lines
- Particular time period
- Apportioned effectiveness measure
- Actual effectiveness measure
- Charges

10. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term "line" in claims 1, 23, 33 and 37 and their dependents is used by the claim to mean "parameters", while the accepted meaning is "a unit of advertising space in a newspaper." The term is indefinite because the specification does not clearly redefine the term. The definition provided in ¶¶ 0014 and 0031 is circular and contradictory.
11. Claims 1-39 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following is a list of terms used throughout the claims that were either completely

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undefined in the specification or were so poorly defined that it was not possible to ascertain their meaning and as a result they rendered the claims indefinite. For the purposes of this examination examiner interpreted the terms below as listed.

- Line = parameter that distinguishes aspects of an ad campaign such as a demographic or media venue (tv vs. internet)
- Web property = a web site (collection of web pages, see ¶0031 of the specification)
- Related to = associated with
- Capping = setting a maximum
- Based on = derived from
- Booked amount = price
- Apportioned = divided

Claim Rejections - 35 USC § 101

12. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

13. Claims 1-4, 6, 8-36 and 39 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The invention claimed in the method steps is an abstract idea because it is directed entirely to a calculation. Abstract ideas are judicial exceptions and are not statutory unless the claims set forth a practical application of the judicial exception. The claims do not set forth a physical transformation; therefore there must be a useful concrete and tangible result to establish the practical application. Here there is not a concrete result. For a result to be concrete, it must be predictable and repeatable. Here the claims loosely require specifying and apportioning various inputs of data in the independent claims. It is entirely reasonable to suppose that two different people may complete a step as required in the claims differently and achieve different results, for example one person may apportion the target GRP

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evenly over time, and one person may apportion the target GRP over time based on external factors like a major media event. Because the claims are not concrete, there is no practical application to the judicial exception for the claimed methods and therefore the methods are not statutory subject matter under 35 U.S.C. § 101.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

16. **Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

17. Claims 1-4, 6-16, 18-27, and 29-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Del Sesto (U.S. 6,985,882) in view of Hennessey (U.S. 2003/0050827).

Claims 1, 23, 33, 37 and 39:

Del Sesto, as shown, discloses the following limitations:

- *specifying a target Gross Rating Point (GRP) for one or more lines of the advertising campaign* (see at least Figure 4J),
- *specifying a total booked amount for the lines* (see at least Figure 4J),

Although Del Sesto does disclose a display and tracking feature of advertisements over time, Del Sesto does not specifically disclose the apportionment of the target GRP as in the limitations below. However, Hennessey, as shown, does:

- *apportioning the target GRP among one or more time periods of the campaign* (see at least Figure 7),
- *apportioning the total booked amount among the time periods* (see at least Figure 7),
- *wherein recognized revenue is based on the apportioned GRP and the apportioned booked amount* (see at least Figure 11),

The primary difference between Del Sesto and Hennessey is that Del Sesto contemplates a prepaid contract and focuses on tracking advertising actually distributed and making good on the contract eventually, while Hennessey has a more “real-time” focus so that it can use data to more accurately predict advertising revenue and set more competitive advertising prices. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the two features above in the context of an “after-the-fact” invoicing plan because the tracking features of Del Sesto combined with the time display format of Hennessey reflect the actual performance and value of the service provider in distributing the advertisement over the defined period of time enabling the advertiser to pay only for the services received and retain its remaining advertising budget until the service provider later makes good on the contract.

Claims 2, 25 and 34:

The combination of Del Sesto/Hennessey discloses the limitations as shown in the rejection above. Although Del Sesto does disclose a display and tracking feature of

advertisements over time, Del Sesto does not specifically disclose the apportionment of the target GRP as in the limitation below. However, Hennessey, as shown, does:

- *the target GRP is apportioned equally among the time periods* (see at least Figure 7 and ¶0027).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the two features above in the context of an “after-the-fact” invoicing plan because the tracking features of Del Sesto combined with the time display format of Hennessey reflect the actual performance and value of the service provider in distributing the advertisement over the defined period of time enabling the advertiser to pay only for the services received and retain its remaining advertising budget until the service provider later makes good on the contract.

Claims 3, 26 and 35:

The combination of Del Sesto/Hennessey discloses the limitations as shown in the rejections above. Although Del Sesto does disclose a display and tracking feature of advertisements over time, Del Sesto does not specifically disclose the apportionment of the target GRP as in the limitation below. However, Hennessey, as shown, does:

- *the booked amount is apportioned equally among the time periods* (see at least Figure 7 and ¶0027).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the two features above in the context of an “after-the-fact” invoicing plan because the tracking features of Del Sesto combined with the time display format of Hennessey reflect the actual performance and value of the service provider in distributing the advertisement over the defined period of time enabling the advertiser to pay only for the services received and retain its remaining advertising budget until the service provider later makes good on the contract.

Claims 4, 24, 36 and 38:

The combination of Del Sesto/Hennessey discloses the limitations as shown in the rejections above. Del Sesto, as shown, discloses the following limitations:

- *determining the actual GRP achieved for the time periods (see at least Figure 4J),*
- *determining recognized revenue for the time periods such that a ratio of the recognized revenue to the total booked amount is based on a ratio of the actual GRP to the target GRP (see at least Figure 4J).*

Claims 6 and 27:

The combination of Del Sesto/Hennessey discloses the limitations as shown in the rejections above. Del Sesto, as shown, discloses the following limitation:

- *the ratio of recognized revenue to the total booked amount equals the ratio of the actual GRP to the target GRP for the lines (see at least Figure 4J).*

Claims 7 and 30:

The combination of Del Sesto/Hennessey discloses the limitations as shown in the rejections above. Although Del Sesto does disclose a display and tracking feature of advertisements over time, Del Sesto does not specifically disclose the apportionment of the revenue as in the limitation below. However, Hennessey, as shown, does:

- *the ratio of recognized revenue for a particular time period to the total booked amount for a particular line is equal to the ratio of actual GRP for the particular time period to the target GRP for the particular line (see at least Figure 11).*

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the two features above in the context of an “after-the-fact” invoicing plan because the tracking features of Del Sesto combined with the time display format of Hennessey reflect the actual performance and value of the service provider in distributing the advertisement over the defined period of time enabling the advertiser to

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pay only for the services received and retain its remaining advertising budget until the service provider later makes good on the contract.

Claims 8, 9, 29 and 31:

The combination of Del Sesto/Hennessey discloses the limitations as shown in the rejections above. Del Sesto does not disclose:

- *determining an invoice amount for a billing period*
- *the invoice amount being calculated by adding recognized revenue for the lines for the time periods falling within the billing period*

However, the Examiner takes **Official Notice** that it is old and well-known in the art to bill advertisers by invoice for services rendered over an established period of time. Furthermore, the Examiner takes **Official Notice** that it is old and well-known that invoice amounts typically represent a sum of the cost of services rendered over the period of time the invoice contemplates.

Ergo, it would have been obvious to one having ordinary skill in the art at the time of the invention to total the *recognized revenue* (which Del Sesto does disclose as shown above) within a prescribed period to determine an invoice amount because this is the only means available within the art (referring to the combination of Del Sesto/Hennessey) to value the service of distributing advertisements in terms of dollars and both the service provider and the advertiser are interested in paying and receiving payment for the value of services rendered.

Claims 10 and 32:

The combination of Del Sesto/Hennessey discloses the limitations as shown in the rejections above. Del Sesto does not disclose the limitation below:

- *adding revenue for a particular time period that falls partially within the billing period based on an amount of time that the particular time period falls within the billing period* (examiner takes official notice that applicant has described

prorating charges for services that may overlap billing cycles, and that such a method is known in the art).

It would have been obvious to one having ordinary skill in the art at the time of the invention to add the commonly known capability of prorating invoices to the methods contemplated by Del Sesto/Hennessy shown above because adding this feature enables the advertiser to see the effectiveness of their advertisements not only over conventional time periods (like weeks or months or days or day parts) but also in a completely customized time period (any arbitrarily defined billing period) which may be beneficial to one or the other for accounting purposes for example.

Claims 11-13:

The combination of Del Sesto/Hennessey discloses the limitations as shown in the rejections above. Del Sesto does not limit time periods to weeks or months, however Del Sesto does contemplate analysis over various time periods, as shown:

- *the time period is a week* (see at least Figure 4L, flight dates),

With regard to the limitation of *wherein the billing period is a month* (Del Sesto does not define billing periods, the examiner takes **Official Notice** that it is old and well-known that a billing period may be a calendar month and in fact a calendar month is a conventional time period to use to define billing cycles. It would have been obvious to one having ordinary skill in the art at the time of the invention to combine the weekly analysis capabilities of the Del Sesto invention with monthly billing cycles because monthly billing cycles are very common in the art and are therefore very accommodating for accounting purposes.

Claim 14:

The combination of Del Sesto/Hennessey discloses the limitations as shown in the rejections above. Del Sesto does not disclose the limitation below:

- *capping the invoice amount for a line to an amount for the line for the billing period,*

Examiner takes official notice that in many service contracts, invoices are capped at a prescribed amount. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to ensure that any invoicing system is capable of working with in such a parameter if necessary.

Claim 15:

The combination of Del Sesto/Hennessey discloses the limitations as shown in the rejections above. Del Sesto, as shown, discloses the following limitation:

- *when a total actual GRP for a billing period for a particular line differs from a total target GRP for the particular line for the billing period, applying the difference between the total actual GRP and the total target GRP for the billing period to a subsequent billing period (see at least Figure 4J).*

Claim 16:

The combination of Del Sesto/Hennessey discloses the limitations as shown in the rejections above. Del Sesto, as shown, discloses the following limitation:

- *when the total actual GRP for the billing period for a particular line is less than the total target GRP for the particular line for the billing period, applying the difference between the total actual GRP and the total target GRP to a subsequent billing period (see at least Figure 4J).*

Claim 18:

The combination of Del Sesto/Hennessey discloses the limitations as shown in the rejections above. Del Sesto discloses the following limitation:

- *each of the lines has an associated target GRP (see at least Figure 4J).*

Claim 19:

The combination of Del Sesto/Hennessey discloses the limitations as shown in the rejections above. Del Sesto, as shown, discloses the following limitation:

- *any difference between an actual weekly GRP and a target weekly GRP is automatically carried over to the subsequent week, if the subsequent week is within the same calendar month (see at least Figure 4J).*

Claim 20:

The combination of Del Sesto/Hennessey discloses the limitations as shown in the rejections above. Del Sesto, as shown, discloses the following limitation:

- *the difference is calculated for each of the lines of the campaign (see at least Figure 4J).*

Claim 21:

The combination of Del Sesto/Hennessey discloses the limitations as shown in the rejections above. Del Sesto, as shown, discloses the following limitation:

- *recognized revenue is separately calculated for each of the lines (see at least Figure 4J).*

Claim 22:

The combination of Del Sesto/Hennessey discloses the limitations as shown in the rejections above. Del Sesto, as shown, discloses the following limitation:

- *the billing period of each of the lines is independent of the other lines (see at least Figure 4B).*

18. Claims 5, 17, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Del Sesto/Hennessey and further in view of Alvarez et al. (U.S. 6,772,129).

Claims 5 and 28:

The combination of Del Sesto/Hennessey discloses the limitations as shown in the rejections above. Del Sesto does not disclose the following limitation as Del Sesto is focused on media distribution in television and radio formats. However, Alvarez, as shown, does disclose the following limitation:

- *serving advertisements on one or more Web pages in accordance with campaign parameters* (see at least the Abstract, "[t]his method measures all known forms of media... such as internet banners and email...").

The Alvarez invention is focuses only on measuring the effectiveness and efficiency of advertising and as such it contemplates a wider array of media. Among the various variables Alvarez uses to establish the effectiveness of an advertisement, Alvarez also relies on a comparison target GRPs and actual GRPs. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the wider media capabilities of Alvarez with the more robust contract/billing monitoring capabilities of Del Sesto because this combination can bring all of the benefits of the Del Sesto invention to campaigns that span the full range of advertising venues.

Claim 17:

The combination of Del Sesto/Hennessey discloses the limitations as shown in the rejections above. Del Sesto does not disclose the following limitation, however Alvarez, as shown, does:

- *each of the lines is related to an individual Web property* (see at least the Abstract, "[t]his method measures all known forms of media... such as internet banners and email...").

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the wider media capabilities of Alvarez with the more robust contract/billing monitoring capabilities of Del Sesto because this combination can bring all of the benefits of the Del Sesto invention to campaigns that span the full range of advertising venues.

Conclusion

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
- Chandler-Pepelnjak et al., U.S. 2003/0074252; hit calculations using target and observed GRP.
 - Dedrick, U.S. 5,724,521; pricing strategy for electronic advertising.
 - Blumenau, U.S. 6,418,470; disclosing how to gather necessary information to calculate GRP.
 - Blumenau, U.S. 6,327,619; disclosing how to gather necessary information to calculate GRP.
 - Calvert et al., U.S. 2003/0014304; using cookies to gather impression information.

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20. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Nathan C Uber** whose telephone number is **571.270.3923**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **James A Reagan** can be reached at **571.270.6710**.
21. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).
22. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to **571-273-8300**.

23. Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**:

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/Nathan C Uber/ Examiner, Art Unit 4143

28 January 2008

/James A. Reagan/Supervisory Patent Examiner, Art Unit 4143